

Application No. 10/689,775

Docket No.2002-061R1
PATENT

Applicants hereby elect the claims defined by Group I (claims 1-9, 12-19 and 22), with traverse as to Group II.

Applicants submit that the Group II claims should not be restricted from the claims of Group I.

Response to Restriction Requirement

The Office action alleges that the claims presented in Group I are directed to an invention that is independent or distinct from the claimed invention of the claims of Group II.

Applicants respectfully traverse the basis for the restriction requirement for the reasons set forth below.

Examination of All Claims would Not Present a Serious Burden

Under MPEP §803, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicants admit that the inventions defined by independent claims 1, 12 and 22 are patentably distinct from the inventions defined by claims 10, 11, 20 and 21. Applicants respectively submit, however, that examination of all of the presently pending claims could be made without serious burden on the Examiner.

A substantial overlap in claim requirements exists between the elected and non-elected claims. Each of the elected claims are drawn to methods for preparing block copolymers, and require, inter alia, polymerizing a hydrophilic monomer and an olefin monomer under polymerization conditions in the presence of a dithio-containing control agent.¹ Each of the non-elected claims are drawn to block copolymers made by the processes of claims 1 and 12, and require, inter alia, that the resulting polymer have the properties that result from the methods defined in the claims. For example, claim 1, requires that the block copolymer can change the surface tension of an olefin substrate by an amount of at least 10mN/m. Also, independent claims 1 and 12 require that the polymerizations occur in the presence of a dithio-containing

¹ The Office action alleges that the methods of the claims in Group I can be used to make other materially different products than a block copolymer, such as a homopolymer. Applicants disagree with this statement as independent claims 1, 12 and 22 are all directed to methods of making block copolymers and recite the use of hydrophilic and olefin monomers.

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control agent, which results in the polymer having certain properties that result from using those materials. See, for example, paragraph [040]. As such, the non-elected claims generally include requirements that are a subset of the requirements of the elected claims – differing in general only with respect to the product and specific block requirements.

In view of such overlap of claim requirements, the search for the elected claims will necessarily include and overlap with the search for the non-elected claims. Applicants respectfully disagree with the Office action assertion that the search required for the non-elected group is not required for the elected group of claims.

In particular, although the methods for evaluating polymerization processes are said in the Office action to be classified in class 526, subclass 234, whereas the polymer products are said to be classified in class 526, subclass 348, such differences in subclass are not sufficient to demonstrate a substantial burden on Examiner.

Hence, because all of the presently pending claims could be searched without an undue burden on the Examiner, restriction is improper.

Election for Restriction Purposes – Subject to Reconsideration

Subject to reconsideration in view of the foregoing remarks traversing the restriction requirement, Applicants hereby elect, without prejudice, the inventions defined by independent claims 1, 12 and 22 (drawn to methods for making block copolymers) and claims dependent therefrom. Hence, the elected claims include, specifically, claims 1-9, 12-19 and 22.

Applicants expressly reserve the right to pursue the non-elected claims (10, 11, 20 and 21) in a divisional application.

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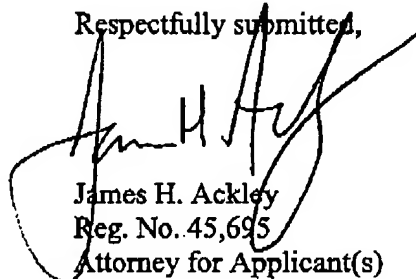
Conclusion

In view of the foregoing, the Applicants request examination on the merits, and submit that each of the pending claims are in condition for allowance.

The Applicant believes that no new fees are required in connection with the instant Amendment A. If necessary, however, the Examiner is authorized to charge any necessary fees to Deposit Account No. 50-0496.

Respectfully submitted,

Date: 2-23-05


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